

REMARKS

Status of the Claims

Claims 1-16 are pending in the present application; claims 17-24 were cancelled in the amendment filed April 14, 2005 (*April 14 Amendment*). The Applicants expressly reserve the right to pursue the subject matter of the cancelled claims through a continuation application. Independent claims 1 and 9 were previously rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. patent number 6,751,312 to Kudoh (*Kudoh*). See January 24, 2005 Office Action, 2 at ¶ 2 (*January 24 Office Action*). The Examiner has withdrawn the rejections under 35 U.S.C. § 102(e) and notes that the "Applicant's [previously submitted] arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection." *June 29 Office Action*, 5 at ¶ 6.

Rejections of Claims 1 and 9 Under 35 U.S.C. § 103(a)

The Examiner now rejects claims 1 and 9 pursuant to 35 U.S.C. § 103(a) "as being unpatentable over Kudoh (6,751,312) in view of Ouselati et al (6,806,865) [*Ouselati*]." *June 29 Office Action*, 2 at ¶ 2. Specifically, the Examiner contends *Kudoh* to disclose a "set of controls including at least one input device for generating a signal representing displacement information (see col. 1, line 42-col. 2, line 6)." *June 29 Office Action*, 2 at ¶ 2. The Examiner further notes that "*Kudoh* does not precisely teach that the input device is an analog input device for generating an analog signal." *June 29 Office Action*, 2 at ¶ 2. The Examiner refers to *Ouselati* for an "analog input device that communicates a (sic) analog signal to computer electronics of a handheld computer representing displacement information (Fig. 1, and col. 3, lines 41-50)." *June 29 Office Action*, 2, ¶ 2.

Concerning the combination of *Kudoh* and *Ouselati*, the Examiner asserts “it would have been obvious to one of ordinary skill in the art at the time the invention was made for the input device of *Kudoh* to be analog, as taught by *Ouselati*, because the use of analog input devices such as joysticks, joypads, and trackballs is overwhelmingly known in the art of handheld computing devices.” *June 29 Office Action*, 3 at ¶ 2. The Applicants traverse the asserted obviousness of the presently claimed invention and contend that the Examiner has failed to establish a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three criteria must be met:

First, there must be some **suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, **to modify the reference** or to combine reference teachings. Second, there must be a **reasonable expectation of success**. Finally, the prior art reference (or references when combined) must **teach or suggest all the claim limitations**.

MPEP § 2143 (emphasis added).

There is No Motivation to Combine the References

The Applicants contend the Examiner has failed to evidence a motivation to combine *Kudoh* with *Ouselati*. As the Examiner is aware, “[t]here are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). The Examiner has made no reference to ‘the nature of the problem to be solved’ nor to ‘the teachings of the prior art’ leaving the only possibility for a motivation to combine to be ‘the knowledge of persons of ordinary skill in the art.’

The *only* statement the Examiner has made concerning a possible motivation to combine is that ‘analog input devices are *overwhelmingly* known in the art.’ The Applicants dispute this blanket assertion concerning *overwhelming* knowledge in that the Examiner has identified only a single reference. The Applicants further note the Federal Circuit’s emphasis in relying on *objective evidence* and making *specific factual findings*

with respect to the motivation to combine, evidence and findings the Applicants contend are lacking in the present rejection. See *In re Lee*, 277 F.3d 1338, 1342-44 (Fed. Cir. 2002); see also MPEP § 2143.01(I).

The mere fact that references *can* be combined does not necessarily render the combination obvious unless the prior art *suggests* the desirability of the combination. See *In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990); see also MPEP § 2141.01(III). In that regard, the Applicants contend that the Examiner's stated support for the present 35 U.S.C. § 103 rejection counters the prohibitions set forth by the Board of Patent Appeals and Interferences in *Ex Parte Levengood*. 28 U.S.P.Q. 1300 (Bd. Pat. App. & Inter. 1993). In *Ex Parte Levengood*, the Board found statements by an Examiner that a combination is well within the ordinary skill of the art at the time the claimed invention was made is *not sufficient* to establish a *prima facie* case of obviousness. The Examiner's reference to *overwhelming knowledge* closely resemble the statements that were ultimately found insufficient to maintain a 35 U.S.C. § 103 rejection in *Ex Parte Levengood*.

The Federal Circuit has established a similar line of law. For example, in *In re Kotzab*, the Court overturned an obviousness rejection for failure to identify a specific understanding within the art that would have motivated one to make the claimed invention. 217 F.3d 1365, 1371 (Fed. Cir. 2000). The Federal Circuit in *Al-Site Corp. v. VSI Int'l Inc.* also found that the level of skill in the art cannot be relied upon to provide the suggestion to combine the references. 174 F.3d 1308 (Fed. Cir. 1999). As such, the Applicants contend the Examiner has failed to properly establish a motivation to combine *Kudoh* and *Ouselati* thereby establishing the lack of a *prima facie* case of obviousness.

Combining Kudoh and Ouselati Would Render Them Inoperable

"If [a] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP § 2143.01(V); see *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). Furthermore, "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." MPEP § 2143.01(VI); see *In re Ratti*, 270 F.2d 810 (CCPA 1959). The Applicants contend the proposed combination of *Kudoh* with *Ouselati* would result in an *inoperable combination* that would further require a *fundamental change* in the operation of the cited references. As such, the Applicants contend the proposed combination would *teach away* from the presently claimed invention and further evidencing the absence of a *prima facie* case of obviousness.

As was noted by the Applicants in the *April 14 Amendment*, *Kudoh* discloses a portable telephone 102 having a stick switch 116. See *Kudoh*, col. 1, l. 30-33; see also *April 14 Amendment*, 5. Stick switch 116 of *Kudoh* comprises a switch box 122 and a stick 124. See *Kudoh*, col. 1, l. 47-48; see also *April 14 Amendment*, 5. The switch box 122 includes one common terminal 132 and five optional terminals (134, 136, 138, 140 and 142) that each correspond to one of terminals A, B, C, D or E. See *Kudoh*, col. 1, l. 56-61 and FIG. 4. *Kudoh* specifically notes that "[w]hen the stick 124 is operated, the common terminal 132 is **connected with either one of the corresponding optional terminals.**" *Kudoh*, col. 1, l. 60-62 (emphasis added). As such, the Applicants previously submitted that "Kudoh illustrates a form of digital switch." *April Amendment*, 5. The Examiner agreed with the Applicants' contention as evidenced by the statement "Kudoh does not precisely teach that the input device is an analog input device for generating an analog signal." *June 29 Office Action*, 2 at ¶ 2.

Being a switch, a connection is or is not made in *Kudoh* between common terminal 132 and one of the five corresponding terminals (A-E). Accordingly, switch 116 is characteristic of a digital on/off switch rather than a continually variable analog device that offers a full continuum of directional movement. See *April 14 Amendment*, 5-6. *Ouselati*, as referenced by the Examiner, discloses a "joypad 125 [that] may be configured to be moved in a continuum of directions from 0-360 degrees and communicate an analog signal to computing electronics of handheld computer 100." *Ouselati*, col. 3, l. 41-44. *Ouselati* further notes that "[j]oypad 125 is configured to communicate an electrical signal to the computing device or data processing electronics of handheld computer 100"; this electrical signal "corresponds to the direction in which the joypad is pressed." *Ouselati*, col. 3, l. 47-50.

The joypad of *Ouselati* that moves in a continuum of directions from 0-360 degrees cannot operate in conjunction with the digital switch of *Kudoh*. *Kudoh* operates as a switch that is either in an on or off position. The stick switch of *Kudoh*, therefore, must be positioned such that one of the five terminals (134, 136, 138, 140 and 142 (A-E)) is connected with the common terminal 132. No such positioning is possible in *Ouselati* in that it operates in a continuum of directions from 0-360 degrees. Any positioning of the joypad of *Ouselati* beyond 0, 90, 180 and 270 degrees would fail to create a connection between the common terminal 132 and terminals positions A, B, C or D as found in *Kudoh*. Additionally, there is no suggestion that *Ouselati* would operate in a downward direction to offer connectivity with terminal E (142) as is required by *Kudoh*. As such, *Kudoh* and *Ouselati* represent an inoperable combination of references. Alternatively, to reconfigure *Kudoh* to allow for such a continuum of operation would require a fundamental change in the operation of *Kudoh* such that it would no longer operate as a digital switch. As such, the Applicants contend there to be no expectation of success in the combination of *Kudoh* and *Ouselati* thereby evidencing the lack of a *prima facie* case of obviousness.

Kudoh and Ouselati Do Not Teach Each and Every Claimed Limitation

The combination of *Kudoh* and *Ouselati* fails to teach each and every limitation of the presently claimed invention. Specifically, *Kudoh* and *Ouselati* fail to disclose an analog input device generating displacement information, that displacement information comprising information representative of a speed at which a displayed object changes position.

As noted by the specification of the present application, the presently claimed analog input device “can control an amount that [a] character or other graphic moves and/or a speed at which that character or other graphic moves within [a] display 112.” *Specification*, 7 at ¶ [21] (emphasis added). The specification notes that “in response to a user moving the analog input device 120 slightly from center, a graphic element can move slightly or slowly in that direction, versus a far and rapid movement when the analog input device 120 is moved to the maximum deflection.” *Specification*, 7 at ¶ [021]. This aspect of the presently claimed invention is not found in *Ouselati* or *Kudoh* further evidencing the lack of a *prima facie* case of obviousness.

Dependent Claims

The Federal Circuit has held if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. See *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988); see *MPEP* § 2143.03. As the Applicants contend claims 1 and 9 to be non-obvious, the Applicants similarly contend dependent claims 2-8 and 10-16 to be non-obvious for at least the same reasons.

CONCLUSION

The Applicants contend the Examiner has failed to establish a *prima facie* case of obviousness as required by 35 U.S.C. § 103(a). Specifically, the Applicants contend the Examiner has failed to evidence a motivation to combine. Additionally, the proposed combination of *Kudoh* and *Ouselati* would represent an inoperable combination in that *Ouselati* would require a fundamental change to the operation of *Kudoh*. Finally, the Applicants contend that the combination of *Kudoh* and *Ouselati*—notwithstanding the lack of motivation to combine and the resulting inoperable combination—would still fail to teach each and every claimed limitation of the presently claimed invention. As such, the Applicants respectfully request the removal of the present rejection and allowance of claims 1 and 9.

The Applicants further contend that all dependent claims are allowable for at least the same reasons as claims 1 and 9.


The Applicants finally note that the amendments to the specification are to provide absent application number information and/or to correct typographical nuances and do not constitute the introduction of new matter.

The Examiner is invited to contact the Applicants' undersigned representative with any questions concerning the present application.

Respectfully submitted,
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